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EXAMINER

MURDOUGH, JOSHUA A

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3621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/643,712	Applicant(s) IRWIN ET AL.	
	Examiner JOSHUA MURDOUGH	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/5/2004, 1/17/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. Claims 1-17 are pending.
2. The preliminary amendment filed August 5, 2004 is acknowledged. In particular, the amendment to the specification has been entered.

Priority

3. In light of Applicants' amendment to the specification, this application is now being examined as a continuation in part of 10/392,496 filed 20 March 2003.

Information Disclosure Statement

4. The IDS entered on 1/17/2008 contained reference to one item for which the date of publication cannot be determined. Therefore, it has NOT been considered by the Examiner.

Drawings

5. The drawings are objected to because it is difficult to read the text within the shaded regions of Figure 4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the

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remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

6. The claims are objected to because the lines are crowded too closely together, making reading difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

7. Claims 1-15 are objected to because of the following informalities: In line 13 of claim 1 the license rights package is debited. The Examiner believes this is directed toward metering functionality. If this is the case, the license rights package should be shown to have this data prior to changing it. Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter (7,133,846).

10. As to claim 1, Ginter shows:

A computer-implemented system for accessing digital content, the system comprising
a media device (Figure 2B, element 100) wherein said media device further
comprises:

a digital rights management system (Abstract);

wherein said media device and digital rights management system may be utilized by a
consumer to perform one or more of the following functions:

a.

download a digital content package (Figure 4, any of elements 152a-i);

create a license rights package to be associated with said digital content package
(Figure 11, element 302);

purchase said license rights package (Figure 10) wherein said license rights
package includes an account number for said consumer (an account number
and transit routing number are needed to process clearinghouse transactions as
shown in Figure 10);

download said license rights package to said media device (Column 111, lines 19-
29);

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debit said license rights package when said consumer accesses said digital content package in accordance with a set of rights included in said license rights package (Column 111, lines 38-46);

when said license rights package is exhausted, renew said license rights package by charging said account number contained in said license rights package (Column 114, lines 49-55);

b.

modify said license rights package and apply a difference to said account number contained in said license rights package (Columns 98-101, lines 49-59, each time the content moves in the chain, the information in the license rights package would have to be changed).

c.

download said license rights package (Figure 4, any of elements 152a-i) to said media device (Figure 4, element 102);

transfer said digital content package and said license rights package to a second consumer (Column 25, lines 45-50);

debit said license rights package when said second consumer accesses said digital content package in accordance with a set of rights included in said license rights package (Column 111, lines 38-46);

modify said license rights package and apply a difference to said account number contained in said license rights package (Columns 98-101, lines 49-59, each

time the content moves in the chain, the information in the license rights package would have to be changed).

11. As to claim 2, Ginter further shows:

when said license rights package is exhausted, said second consumer may renew said license rights package by charging said account number contained in said license rights package (A new user cannot be allowed to incur charges on the first user's account, therefore it is inherent that when contents are redistributed, as shown in Ginter (Column 131, lines 38-49), the account information is changed).

12. As to claim 3, Ginter further shows:

when said license rights package is exhausted, said second consumer may renew said license rights package by charging, at said second consumer's option, a new account number and a new license rights package will contain said new account number (A new user cannot be allowed to incur charges on the first user's account, therefore it is inherent that when contents are redistributed, as shown in Ginter (Column 131, lines 38-49), the account information is changed. The second consumer has to provide this account information, and therefore has the option as to what information is provided.).

13. As to claim 4, Ginter further shows:

said digital rights management system may access a license storage (the license being implemented through the metering mechanism, Figure 1B, element 116) on said media device to determine if a set of license rights exist for an access desired by said consumer (Column 17, lines 39-49).

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14. As to claim 5, Ginter further shows:

said digital rights management system will not allow access to said digital content package if an associated license rights package is not available (the certificate contained within the package needs to be present to allow access, Column 118, lines 26-34).

15. As to claim 6, Ginter further shows:

said digital rights management system will prompt said consumer to procure a license rights package if said license rights package does not exist in said license storage (Column 28, lines 54-62).

16. As to claim 7, Ginter further shows:

said digital rights management system will prompt said consumer to renew a license rights package if said license rights package has been debited enough to trigger a predetermined expiration warning (Columns 28-29, lines 63-6).

17. As to claim 8, Ginter further shows:

said digital rights management system will prompt said consumer to procure additional rights for a license rights package if said license rights package does not include said additional rights (Figure 45A, all of the purchasable rights are stored in the rights template along, if a consumer wishes to perform an action for which the rights have not been purchased, they will have to purchase the rights prior to the action; Column 75, lines 9-39).

18. As to claim 9, Ginter further shows:

a rating engine (Column 75, lines 9-19, element 450);

wherein said license rights package (original license rights package) further comprises metadata (Figure 45C, element 188) which may be utilized by said rating engine to:

calculate a cost for an additional license rights package without contemporaneously connecting to a host system (Columns 28-29, lines 63-6, When the original permissions were downloaded, the information regarding the price was acquired, not when the rights are purchased); and

create a new license rights package further comprising said account number associated with said original license rights package (inherently, a package must be modified, thus creating an new package to reflect the new rights);

selectively transmit a charge associated with said additional license rights package and said account number associated with said additional license rights package to said host processor (debit the consumers electronic wallet, Column 29, lines 3-6).

19. As to claim 10, Ginter further shows:

a rating engine (Column 75, lines 9-19, element 450);

wherein said license rights package (original license rights package) further comprises metadata (Figure 45C, element 188) which may be utilized by said rating engine to:

calculate a cost for an additional license rights package without contemporaneously connecting to a host system (Columns 28-29, lines 63-6, When the original permissions were downloaded, the information regarding the price was acquired, not when the rights are purchased); and

- modify said license rights package to include said set of additional rights(inherently, a package must be modified, thus creating an new package to reflect the new rights);
- selectively transmit a charge associated with said additional license rights package and said account number associated with said additional license rights package to said host processor (debit the consumers electronic wallet, Column 29, lines 3-6).
20. As to claim 11, Ginter further shows:
- said additional license rights package may be structured to provide rights on a per use basis (Figure 45A, pay per use/action/view pricing modles).
21. As to claim 12, Ginter further shows:
- said additional license rights package may be structured to provide rights on a time spent basis (Columns 54-55, lines 62-7).
22. As to claim 13, Ginter further shows:
- said additional license rights package may be structured to provide rights on a subscription basis (Column 79, lines 7-11).
23. As to claim 14, Ginter further shows:
- said additional license rights package may be structured to provide rights according to a quantum of digital content accessed basis (Column 54, lines 26-39, e.g. first chapter is free, additional chapters cost).
24. As to claim 15, Ginter further shows:
- said additional license rights package may be flexibly structured to provide rights according to the preferences of a customer (Figure 45A, The template shows all of

the purchasable rights, but the customer only has to purchase the ones they prefer).

25. As to claim 16, Ginter shows:

A computer-implemented system for accessing digital content, the system comprising a media device (Figure 2B, element 100) further comprising a digital rights management system (Abstract) and a rating engine (Column 75, lines 9-19, element 450); a content server (Figure 21, element 168, for digital content over a network, the publisher would have to be a content server); and a license server wherein said content server is configured to store and index digital content (Figure 11, element 300); said license server is configured to store a plurality of data and algorithms (Figure 11, elements 302 and 304a-d) to be associated with a particular set of digital content (digital content package (Figure 11, elements 152a-e) said media device is configured to access said content server to search said content server for a particular digital content package (Figure 11, element 152b); download said digital content package to said media device (Figure 11, element 152b, download shown by arrow to device comprising elements 102, 104, 106, 116 and 154) wherein said digital content package is further configured with an identifier (inherent to include an identifier, in order for the package to be accessed); and said media device is configured to access said license server (Figure 11, arrow from device comprising elements 102, 104, 106, 116 and 154 to element 300);

access a set of data and algorithms associated with said selected digital content package via said identifier (Figure 17D-3, 90B);
create a license rights package for said downloaded digital rights (Figure 11, element 302);
charge said license rights package to an account associated with a consumer procuring said license rights package (Figure 10);
incorporate said account number in said license package for future charges (an account number and transit routing number are needed to process clearinghouse transactions as shown in Figure 10);
download said license rights package to said media device (Column 111, lines 19-29);
and
said digital rights management system confirms a license rights package exists when said consumer attempts to access said digital content package on said media device (Column 17, lines 39-49);
if a desired access is included on said license rights package;
said digital rights management system debits said license package for said desired access and permits said access (Column 28, lines 54-62).

26. As to claim 17, Ginter further shows:

said digital rights management system is further configured so that if a desired access is not included in said license rights package, said digital rights management system prompts said consumer to renew or extend said license rights package (Column 28, lines 54-62) by charging a renewal or extension to said account

number associated with the inadequate license rights package (Column 114, lines 49-55).

Claim Interpretation

27. As per claims 16 and 17, the the Examiner interprets claim limitations that contain “*if, may, might, can, when and could*” statement(s), as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. For the sake of speeding up the prosecution process, the Examiner has taken these limitations into account, but they will not be given patentable weight unless positively recited.

Conclusion

28. This application is a continuation-in-part (“CIP”) application of U.S. application no. 10/392,496 filed on 20 March 2003 (“Parent Application”). See MPEP §201.08. In accordance with MPEP §609.02 A. 2 and MPEP §2001.06(b) (last paragraph), the Examiner has reviewed and considered the prior art cited in the Parent Application. Also in accordance with MPEP §2001.06(b) (last paragraph), all documents cited or considered ‘of record’ in the Parent Application are now considered cited or ‘of record’ in this application. Additionally, Applicant(s) are reminded that a listing of the information cited or ‘of record’ in the Parent Application need not be resubmitted in this application unless Applicant(s) desire the

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information to be printed on a patent issuing from this application. See MPEP §609.02 *A. 2.*

Finally, Applicant(s) are reminded that the prosecution history of the Parent Application is relevant in this application.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M./

Examiner, Art Unit 3621

/Andrew J Fischer/

Supervisory Patent Examiner, Art Unit 3621